

REMARKS

In the application claims 68-129 remain pending. Claims 1-67 have been canceled without prejudice. Various of the claims have been amended to further clarify what is regarded as the invention. The amendments find support in the specification, figures, and/or claims as originally filed. No new matter has been added.

In the application claims 72-81 have been indicated to be allowable. Claims 68-71 and 82-129 have been rejected. The reconsideration of the rejection of the claims is, however, respectfully requested.

In the Office Action pending claims 110-119, 123, 124, 128, and 129 were rejected under 35 U.S.C. § 112 as being indefinite. In response, the claims have been amended to clarify what is regarded as the invention and to cure the informality noted with respect to the acronyms. Believing that the amendments place the claims into compliance with 35 U.S.C. § 112, it is respectfully requested that this rejection be withdrawn.

In the Office Action pending claims 68-71 were rejected under 35 U.S.C. § 103 as being rendered obvious by Stefanik (U.S. Patent No. 6,750,801) as modified by Kaario (U.S. Publication No. 2005/0242167) as further modified by Nickum (U.S. Patent No. 6,359,661); pending claims 82-86, 93-97, 108-109, 111, 115-119, 121, and 126 were rejected under 35 U.S.C. § 103 as being rendered obvious by Yang (U.S. 6,133,847) as modified by Kitao (U.S. 6,124,804), as further modified by Sarma (an article entitled "The Networked Physical World") or Brock (an article entitle "The Electronic Product Code"); and pending claims 110, 112-114, 120, 122-125, and 127-129 were rejected under 35 U.S.C. § 103 as being rendered obvious by Yang as modified by Kitao.

In response to these rejections, it is respectfully submitted that, while Section 2143.03 of

the MPEP requires the “consideration” of every claim feature in an obviousness determination, to render a claim unpatentable the Office must do more than merely “consider” each and every feature of a claim. Instead, an asserted combination of references must also teach or suggest each and every claim feature. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including … ascertaining the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). It is for this reason that Section 904 of the MPEP instructs Examiners to conduct an art search that covers “the invention as described and claimed.” (emphasis added). Lastly, Applicant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In sum, it is respectfully submitted that an obviousness rejection that does not explain where or how the references being relied upon disclose each and every element claimed, considering each and every word thereof, cannot be

maintained. See *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Turning now to the rejection of 68-71 under 35 U.S.C. § 103 in view of Stefanik as modified by Kaario as further modified by Nickum, it is respectfully submitted that, while the rejection of the claims does provide a summary of what is disclosed within each of these references, the rejection of the claims fails to explain where or how these references disclose each and every element claimed, considering each and every word thereof. By way of example only, rather than show where or how these references, when combined, disclose, teach, or suggest each and every element claimed, considering each and every word thereof, the rejection of the claims has merely concluded that, when combined, the references render the claimed invention obvious. Thus, because the rejection of the claims has failed to make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art” as is required of a rejection under 35 U.S.C. § 103, it is respectfully submitted that the rejection must be withdrawn.

Considering the rejection still further, it has been acknowledged within the Office Action that, while Stefanik discloses a method of configuring an appliance by providing configuration data to an appliance utilizing a smart card inserted into a remote control, Stefanik fails to disclose, teach, or suggest the claimed storing within a memory device in an appliance *a mapping between one or more configured appliance operational preferences and an individual* or the claimed *using of data received from an RFID tag and forwarded from a universal remote control to retrieve from the memory device in the appliance the one or more configured appliance operational preferences that have been mapped to the individual represented by the data received from the RFID tag and configuring the appliance according to the retrieved,*

configured appliance operational preferences. As further concerns the reliance within the rejection upon the mere disclosure within Stefanik that information stored on the removable smart card could also contain user Internet profiles and information including access to email, Internet browser bookmarks, account names, address lists, hosts, security features, and display formats pertaining to Internet browsing on a television monitor it is respectfully submitted that this disclosure does not expressly or inherently disclose, teach or suggest *using of data received from an RFID tag and forwarded from a universal remote control to retrieve from the memory device in an appliance one or more configured appliance operational preferences that have been mapped to an individual represented by the data received from the RFID tag.* *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991) (To be “inherently” described in a reference, the reference “must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill.” Inherency “may not be established by probabilities or possibilities.”)

Considering now Kaario, it is respectfully submitted that Kaario discloses two alternative methods for configuring an appliance. In the first described method, Kaario discloses, teaches, and suggests configuring an appliance by *uploading information about a user's preferences* to the appliance via a removable media such as a memory card or disk or via an RFID token. (para. 0036). In the second described method, meant to **overcome the perceived limitations associated with uploading information to an appliance via use of a memory card or the like** (para. 0005), Kaario describes using an RFID tag/token that contains a pointer to a relay location on a network which, in turn, contains an Internet URL to an Internet server having profile information for a user (paras. 0009, 0010) such that, when the RFID token of Kaario establishes a link with a smart appliance, the RFID token of Kaario conveys the relay location to the smart

appliance, the smart appliance accesses the relay location, the relay location responds by sending the profile URL to the appliance, *and then* the appliance attempts to link with/download the profile using the profile URL. (para. 0013). In this manner, the second described embodiment of Kaario is meant *not to maintain and, hence, retrieve from memory in a controllable appliance configured profile data* but is meant to maintain and, hence, download from a centralized store profile data to thereby provide the ability to move profile or preference data from that central store to various controllable appliances as needed. (para. 0021 and paras. 0063 and 0064 cited to in the latest Office Action). Accordingly, it is respectfully submitted that Kaario, like Stefanik, fails to disclose, teach or suggest at least the claimed elements of using of data received from an RFID tag and forwarded from a universal remote control to retrieve from the memory in an appliance one or more configured appliance operational preferences that have been mapped to the individual represented by the data received from the RFID tag and configuring the appliance according to the retrieved, configured appliance operational preferences. It is further respectfully submitted that Kaario, when considered in its entirety as is required, teaches directly against the invention set forth within claims 68-71 and, as such, is not properly relied upon in connection with presenting a *prima facie* case of obviousness.

It is additionally respectfully submitted that para. 39, line 5 of Kaario also relied upon in the rejection has no relevance to the invention claimed. In this regard, para. 39, line 5 of Kaario discloses, teaches, and suggests nothing more than the fact that, in the first described method of Kaario (which is expressly described as being distinct from the method utilizing URLs or IP addresses) information can be uploaded about a user's preferences via the removable media such as a memory card or disk or via an RFID token (para. 0036) and then stored on the mass storage device of the computer for use **or** information can be uploaded about a user's

preferences via the removable media such as a memory card or disk or via an RFID token (para. 0036) and then stored on the mass storage device of another device for use. As will be appreciated, when preference information is allowed to be “uploaded” directly from a memory card, disk, or via an RFID token, there simply is no need nor would there be a desire to allow for “retrieval” of such data which is, accordingly, why Kaario describes an alternative embodiment. Nevertheless, it is again submitted that nothing within Kaario expressly or inherently describes that preference information is mapped to anything within a memory in a controllable appliance to allow such information to be retrieved and used, let alone in response to receiving from a remote control data indicative of an individual that is first received at a remote control from a read tag.

Turning now to Nickum, Nickum discloses a system in which a user id, comprised of a predetermined sequence of alphanumeric keys, is provided to a remote control which, in turn, is used at an appliance to determine a level of access to the appliance. (Col. 4, line 66-Col. 5, line 20). Accordingly, like each of Stefanik and Kaario, Nickum fails to disclose, teach or suggest at least the claimed elements of using data received from an RFID tag and forwarded from a universal remote control to retrieve from the memory device in an appliance one or more configured appliance operational preferences that have been mapped to the individual represented by the data received from the RFID tag and configuring the appliance according to the retrieved, configured appliance operational preferences as claimed.

From the foregoing, it is respectfully submitted that the rejection of claims 68-71 fails to present a *prima facie* case of obviousness for at least the reason that the references being relied upon fail to disclose all of the elements that are recited within the claims. In particular, it is respectfully submitted that no reference of record discloses, teaches, or suggests at least the claimed elements of using data received from an RFID tag and forwarded from a universal

remote control to retrieve from the memory device in the appliance the one or more appliance operational preferences configured at the appliance that have been mapped to the individual represented by the data received from the RFID tag and configuring the appliance according to the retrieved, configured appliance operational preferences. For this reason, it is respectfully submitted that the rejection of claims 68-71 under 35 U.S.C. § 103 must be withdrawn.

It is further respectfully submitted that, to the extent that it is being asserted that it would have been obvious to modify Stefanik to arrive at the claimed invention because Kaario discloses an RFID tag used in a setup process and Nickum discloses the use of a remote control and user ids in a setup process, it is well settled that the mere identification of elements selected in isolation from the prior art is insufficient to demonstrate the obviousness of a claimed invention. Rather, a *prima facie* case of obviousness further requires a demonstration that some reason exists, outside of the Applicant's disclosure, for one of skill in the art to arrive at the invention claimed. In the instant case, it is respectfully submitted that no reference of record, other than the Applicant's disclosure, provides any reason or otherwise teaches or suggests modifying Stefanik to thereby provide the expressly claimed appliance configuration method. In this regard, it will be appreciated that Kaario suggests using an RFID tag that contains a pointer to a relay location on a network which, in turn, contains an Internet URL to an Internet server having profile information for a user as a substitute for the Stefanik memory card while Nickum suggests using a predetermined sequence of keystrokes provided to a remote control to determine appliance access as a substitute for the Stefanik memory card which substitutions, if made, would not result in Stefanik becoming the claimed invention, particularly considering each and every word thereof. Thus, because both Kaario and Nickum fail to disclose, teach, or suggest modifying Stefanik to arrive at the claimed invention, because both Kaario and Nickum suggest

alternative and viable ways to achieve appliance configuration and thereby demonstrate that one of skill in the art would not necessarily even consider modifying Stefanik in a manner that would lead one of skill in the art to the claimed invention (with Kaario in fact teaching against the method claimed), and because the Office Action otherwise fails to provide any reason with some rational underpinning to explain why one of skill in the art would have been led to modify Stefanik to arrive at the claimed invention, it is respectfully submitted that the rejection of claims 68-71 under 35 U.S.C. § 103 must be withdrawn.

As to the rejection of claims 82-86, 93-97, and 108-109 under 35 U.S.C. § 103 in view of Yang as modified by Kitao as further modified by Sarma or Brock, it is similarly respectfully submitted that the rejection fails to show where or how these references, when combined, disclose, teach, or suggest each and every element claimed, considering each and every word thereof, but has merely concluded that, when combined, the references render the claimed invention obvious. Thus, because the rejection of the claims has failed to make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art” as is required of a rejection under 35 U.S.C. § 103, it is respectfully submitted that the rejection must be withdrawn.

Considering now the rejection in detail, it was acknowledged that, among other things, Yang fails to disclose, teach, or suggest receiving into a remote control data from a machine readable tag having standardized information that functions to identify an appliance and manufacturer of an appliance and using the received data to configure the remote control. It is additionally respectfully submitted that, by this acknowledged omission, Yang must fail to disclose, teach, or suggest the claimed receiving data into a universal remote control data from a machine readable tag via a device of the universal remote control dedicated to obtaining data

from the machine readable tag, using the data received into the universal remote control to access information to be used to configure the universal remote control, using the information accessed as result of the received data by a setup procedure to configure the universal remote control, and/or using a separate transmission circuit to transmit commands to an appliance to be controlled from a now configured remote control. Rather, in direct contrast, Yang discloses a device in which a single data interface (110) is to be utilized, regardless of the physical media/channel by which data is to be obtained, for *both* downloading code from an appliance and for transmitting function control signals from a remote control device to an appliance. (Col. 3, line 36-56; Col. 3, line 66-Col. 4, line 14, etc.). Accordingly, it is respectfully submitted that Yang not only fails to disclose, teach, or suggest the core of the invention set forth within the claims but, in fact, teaches directly against the invention that is claimed. For at least this reason it is respectfully submitted that the espoused modification of Yang would impermissibly change the principle of operation of Yang and, as such, the rejection of claims 82-86, 93-97, and 108-109 under 35 U.S.C. § 103 must be withdrawn.

Considering now Kitao, it is respectfully submitted that Kitao, like Yang, discloses a system in which an appliance is required to be provided with the hardware and software necessary to configure a remote control to communicate with that appliance. Specifically, Kitao discloses a system wherein (1) an electronic device to be controlled is selected on a remote controller 100 which causes the remote controller 100 to send a trigger signal to an appliance; (2) a remote control interface 109 of the appliance responds to the trigger signal by sending a “device code” back to the remote controller 100; and (3) the device code itself is used by the remote controller 100 to configure the remote controller 100 with a command set to which the target appliance responds (Col. 4, lines 58-64). Thus, like Yang, Kitao fails to disclose, teach, or

suggest the claimed receiving data into a universal remote control from a machine readable tag via a device of the universal remote control dedicated to obtaining data from the machine readable tag, using the data received into the universal remote control to access information, and *using in a setup procedure* of the universal remote control *the information accessed as a result of receiving the data to cause select commands to be mapped to select keys* and thereby configure the universal remote control to transmit commands to an appliance.

While each of Yang and Kitao disclose, teach, and suggest a system in which an appliance is provided with the software and hardware necessary to facilitate remote control setup and, therefore, each of Yang and Kitao fails to disclose, teach, or suggest the claimed receiving data into a universal remote control data from a machine readable tag via a device of the universal remote control dedicated to obtaining data from the machine readable tag, using the data received into the universal remote control to access information, and using in a setup procedure of the remote control the information accessed as a result of receiving the data to cause select commands to be mapped to select keys and thereby configure the universal remote control, it is respectfully submitted that Sarma and Brock also fail to disclose, teach, or suggest these claimed elements.

Considering now Sarma and Brock, while both Sarma and Brock disclose the use of tags, such as RFID tags, having product information, it is respectfully submitted that neither Sarma nor Brock disclose, teach, or suggest using such tags in connection with a remote control configuration process as is claimed. More particularly, Sarma and Brock, like Yang and Kitao, fail to disclose, teach, or suggest providing to a universal remote control a device dedicated to obtaining data from the machine readable tag, using the data received into the universal remote control to access further information to be used to configure the universal remote control, and

using the further accessed information by a setup procedure to cause select commands to be mapped to select command keys as claimed. Rather, Sarma merely states that “*...it is likely that [RFID] tags will find new and unexpected uses.*” (page 7, section 4.3, second paragraph). It is respectfully submitted that nothing within the record evidences that the claimed invention is not one such new and unexpected use for RFID tags. It is also respectfully noted that the Auto-ID Center at MIT, publisher of both Sarma and Brock, similarly failed to contemplate using RFID tags in the manner claimed, instead noting a focus on (a) simple and inexpensive RFID tags to (b) *enhance supply chain and store management processes* in (c) the fast moving consumer goods industry. (www.autoidlabs.org/mission/page.html).

From the foregoing, it is respectfully submitted that the rejection of claims 82-86, 93-97, and 108-109 fails to present a *prima facie* case of obviousness for at least the reason that the references being relied upon fail to disclose all of the elements that are recited within the claims. In particular, it is respectfully submitted that no reference of record discloses, teaches, or suggests at least the claimed elements associated with providing to a universal remote control a device dedicated to obtaining data from the machine readable tag, using the data received into the universal remote control to access information to be used to configure the universal remote control, and using in a setup procedure the information accessed as a result of receiving the data to cause select commands to be mapped to select keys to thereby configure the universal remote control to transmit commands to an appliance. For this reason, it is respectfully submitted that the rejection of claims 82-86, 93-97, and 108-109 under 35 U.S.C. § 103 must be withdrawn.

It is further respectfully submitted that, to the extent that it is being asserted that it would have been obvious to modify Yang to arrive at the claimed invention because Kitao discloses use of appliance identifying data to configure a remote control and Sarma and Brock disclose tags

having identifying data, it is well settled that the mere identification of elements selected in isolation from the prior art is insufficient to demonstrate the obviousness of a claimed invention. Rather, a *prima facie* case of obviousness further requires a demonstration that some reason exists, outside of the Applicant's disclosure, for one of skill in the art to arrive at the invention claimed. In the instant case, it is respectfully submitted that no reference of record, other than the Applicant's disclosure, provides any reason or otherwise teaches or suggests modifying Yang to thereby provide the expressly claimed remote control configuration method. In this regard, it will be appreciated that Yang and Kitao already provide systems that are adapted to configure a remote control and neither Yang nor Kitao suggest the desirability of or need for the particularly claimed invention. Similarly, neither Sarma nor Brock disclose, teach, or suggest that it would be desirable or even useful to modify the system of Yang to use tags in a remote control configuration process, let alone to modify and extensively redesign the system of Yang to provide a remote control with a device dedicated to obtaining data from the machine readable tag and programming for using the data received into the universal remote control to access information to be used to configure the universal remote control and for using the accessed information to configure the universal remote control to transmit commands to an appliance. Thus, because no reference of record discloses, teaches, or suggests modifying Yang to arrive at the claimed invention, because Kitao suggests an alternative and viable way to achieve remote control configuration without the use of tags and thereby demonstrates that one of skill in the art would not necessarily even consider modifying Yang in a manner that would lead one of skill in the art to the claimed invention, because both Sarma and Brock are directed to the use of RFID tags to *enhance supply chain and store management processes* and are not even concerned with remote control configuration, and because the Office Action otherwise fails to provide any

reason with some rational underpinning to explain why one of skill in the art would have been led to modify Yang to arrive at the claimed invention, it is respectfully submitted that the rejection of claims 82-86, 93-97, and 108-109 under 35 U.S.C. § 103 must be withdrawn.

As to the rejection of claims 110, 112-114, 120, 122-125, and 127-129 under 35 U.S.C. § 103 as being obvious by Yang as modified by Kitao, it is again respectfully submitted that the rejection fails to show where or how these references, when combined, disclose, teach, or suggest each and every element claimed, considering each and every word thereof, but has merely concluded that, when combined, the references render the claimed invention obvious. Thus, because the rejection of the claims has failed to make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art” as is required of a rejection under 35 U.S.C. § 103, it is respectfully submitted that the rejection must be withdrawn.

Considering now the rejection in detail, it is respectfully submitted that no art of record discloses, teaches, or suggests at least the claimed using by a setup procedure of information *corresponding* to a device identifier, particularly an identifier received from a radio-frequency identification tag or information retrieved from a node that corresponds to a device identifier that is first received at the remote control and provided to the node, to configure the remote control to control operations of an appliance as claimed. As discussed above, it has been acknowledged that Yang does not disclose this claimed aspect of the invention. As further discussed above, it has been acknowledged that Kitao discloses using a device identifier alone that is received at the remote control to configure the remote control. As such, it is respectfully submitted that the rejection of at least claims 110-129 fails to present a *prima facie* case of obviousness for at least the reason that the references being relied upon fail to disclose all of the elements that are recited

within the claims, and as such, it is respectfully submitted that the rejection of at least claims 110-129 under 35 U.S.C. § 103 must be withdrawn.

Conclusion

It is respectfully submitted that the application stands in condition for allowance. Such action on the part of the Examiner is respectfully requested.

In an effort to expedite the prosecution of the subject application it is respectfully requested that the Examiner contact the undersigned should the Examiner have any further questions or comments concerning the claims currently pending.

Respectfully Submitted;



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